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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,120	08/22/2001	Todd Robert Colas	NOW0730	8373

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EXAMINER

RETTA, YEHDEGA

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 07/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,120

Applicant(s)

COLAS ET AL.

Examiner

Yehdega Retta

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This office action is responsive to communication filed May 08, 2003.

Response to Arguments

1. Applicant's arguments filed May 08, 2003 have been fully considered but they are not persuasive.

Regarding claim 12, applicant argues that "...what is being accessed in the database is also recited so that the limitation explicitly recites what is being accessed (Ad Box default template or Ad master template) and by what item associated with what is being accessed it is being accessed by (one of said plurality of roles associated with the Ad Box default template or Ad Master template. Therefore, the claim will be interpreted as claiming accessing of the Ad Box default templates or A Master Template and Ad Box instances, in the database, by plurality of roles associated with the Ad Box default template or Ad Master template to perform one of creating, ...".

Regarding claims 1 and 20, Applicant argument that the prior art is not a teaching but a marketing device containing exaggerated and as yet to be released product. Applicant also argues, that "Applicants observation that a business organization relying on a business rules application is going to have that application under strict configuration control. Further argues that change implementation is never done by business analysts and end users because it would result in a non-working business rules system...the claim in the prior art that their new capabilities bring this technology beyond just highly skilled developers to a wider community of business analysts and end users is just hype.... is mere speculation. The prior art states that ILOG JRules 3.0 simplifies business rule

Art Unit: 3622

definition and implementation for (B2B e-business) application, as well as workflow management, logistics and exchanges. The prior art further states “also included are sample business rule languages that can easily be extended and customized to a specific application or industry”. Publication of advertisement being one of specific application or industry. Therefore, The prior art teaches means for specifying companies business rules.

Applicant also argues that the prior art, Kashino, does not teach specifying company advertiser and ad publisher personnel roles to accomplish preparation and administration of ads for publication; and any advertiser roles both as recited by claims 1 and 20 but merely states that correction work is done by an advertiser who participate in the publication work. Applicant states that Kashino teaches ad creation (editor) and correction roles (designer and copy writer). Applicant also states, that “The advertiser’s demand is not a business rule, according to the definition provided by the Office Action. Examiner does not understand what definition was used in the Office Action. Applicant should be specific on what definition was provided by the Office action, if it was provided. Unless Applicant provides specific definition, the word “administration” will be broadly interpreted. The prior art, Kashino, teaches preparation and administration, (i.e. creation, maintenance, storing, etc.), of advertisement. Kashino teaches workflow for advertiser publishing advertisement and for publishing company preparing the advertisement in accordance to advertisement’s demand (see col. 8 line 48 to col. 9 line 53). As stated before, Kashino does not explicitly teach specifying the business rule of preparation and administration and personnel roles to accomplish the preparation and administration of the advertisement and storing the rules and roles in a database. That is

Art Unit: 3622

taught in the Press release article for ILOG JRules Software. The press release teaches software for business rules creation or definition using the business terminology specific to an industry rather than a one-size-fits-all business rule language. The press release, therefore, teaches specifying business rules customized to a specific application or industry. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement ILOG's software for specifying business rules in Kashino's preparation and administration of ads for the purpose of describing and controlling the structure, operation and strategy of the publication business.

Regarding claim 5, Applicant's argument that Johnson does not cure the deficiencies of Kashino, Examiner disagrees. Johnson teaches the use of template in order to quickly and easily create presentation.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 20, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kashino U.S. Patent No. 6,166,716, in view of ILOG JRules Software as taught by article "New ILOG JRules Software is First to Bring Business Rule Creation to Business People" PR Newswire; New York; Apr 5, 2000, hereinafter as "ILOG".

3. Regarding claims 1-4, 20, 25 and 26, Kashino teaches company advertiser and ad publisher personnel roles to accomplish preparation of ads for publication wherein the

Art Unit: 3622

ads are formatted for a least one ad delivery medium (see col. 8 line 48 to col. 9 line 28).

Kashino teaches preparation and administration of ads for publication by said roles according to business rules (see fig. 7 and related columns). Kashino does not explicitly teach specifying business rules to control preparation and administration of ads for publication and storing the rules and personnel roles in a database. ILOG teaches specifying customized business rules for specific application or industry. ILOG teaches specifying business rule definition and implementation as well as workflow management, logistics and exchanges (see page 1-3). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Kashino's publishing of ads and ILOG's software for creating business rules. One would be motivated implement ILOG's software to create business rules and Kashino's publishing of ads for the purpose of describing and controlling the structure, operation and strategy of the publication business. Both Kashino and ILOG teach networked (Internet), distributed and replicated database and a web browser (see Kashino col. 8 line 48 to col. 9 line 28 and ILOG page 3).

4. Claims 5-19 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kashino U.S. Patent No. 6,166,716, in view of ILOG JRules Software as taught by article "New ILOG JRules Software is First to Bring Business Rule Creation to Business People" PR Newswire; New York; Apr 5, 2000, hereinafter as "ILOG " and further in view of Johnson et al. U.S. Patent No. 6,453,302.

5. Regarding claims 5-19 and 21-24, Kashino, as modified, does not explicitly teach Ad Box default template defining a plurality of entries for each ad box instance or ad

Art Unit: 3622

Master template defining a plurality of components for each master instance; the ad box default template and ad master template being defined by at least one of company advertiser or ad publisher being controlled by at least one of the plurality of business rules; storing the template (see col. 5 lines 33-67, col. 7 line 29 to col. 8 line 11) ... associated business rules; the business rule determining deadlines and attribute of entries for each ad box and ad master instances; creation, editing and storing of the ad templates and associated business rules, sending to publisher, setting and status ... (see col. 8 line 57 to col. 9 line 59). Johnson teaches a presentation generation system, which integrates customer specific information with a selling entity element to generate a presentation item for sale of product customized for a particular customer of the selling entity (see abstract). Johnson teaches templates used to develop a presentation item (ad) and templates used by the customer solution system to receive customer information and to generate a customer solution, templates such as programs, rules or instructions which perform the functions of ... (see col. 8 lines 43-56). Johnson teaches the template being used to generate customized presentation items, including presentation format templates indicating, the various information to be integrated to form a presentation item (ad). The presentation format template associated with rules defining, for example, the layout of a presentation item which implies that templates being controlled by associated business rules and being defined by at least one of company advertiser and ad publisher. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to modify Kashino's publication of ads by including Johnson's templates associated with and controlled by business rules in order to quickly and easily create the presentation (ad).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Art Unit: 3622

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Steve Gravini for us
Yehdega Retta
Examiner
Art Unit 3622

**STEPHEN GRAVINI
PRIMARY EXAMINER**

YR
July 18, 2003